

Appl. No. 09/936,759
Amdt. dated 16 June 2005
Reply to Office Action of 16 February 2005

Amendments to the Drawings:

The attached seven sheets of drawings, Figures 5A-G, replace original Figures 5A-C. Figures 5A-G present identical sequences as found in the original figures, but with the sequences in Figures 5A-E presented in a larger, more readable typeface. Because of the larger typeface, less sequence data are presented on each line and consequently the numeric identifiers at the ends of the lines, provided for convenience only, have been changed accordingly. No annotated sheets are provided as no change in the sequence was made.

Attachment: Replacement Sheets (7)

REMARKS

Reconsideration of this Application is respectfully requested. Claims 36, 37, and 60-63 are pending; no claim is currently amended; claims 1-35 and 38-59 were previously canceled without prejudice; no claim is original; no new claims are added. The Remarks below are directed to the rejections of the outstanding Office Action.

Objections

Drawings: In compliance with the Examiner's request, Figures 5A-G, new drawing sheets to replace Figures 5A-C, are submitted herewith. The typeface in the amended drawings has been increased in size to meet the requirements of the Patent Office. Numerical indicators of the sequence have been changed as necessary to reflect fewer number of residues per line. No changes have been made to the sequences. It is believed that these drawings satisfy the Patent Office regulations.

Declaration: The Office found the declaration to be defective because a U.S. patent application was erroneously listed as a foreign application. A new Declaration signed by the inventors is submitted herewith; the Declaration identifies the instant application by filing date and serial number as well as correctly identifies the PCT international application as the foreign application to which priority is claimed.

Priority: On page 3 of the OA, the Examiner notes that the instant application lacks reference to priority applications. The specification is amended to insert a first sentence that properly cites priority applications. We thank the Examiner for reminding us of the time period allowed to claim priority without filing a petition. It is believed however, that a petition to have the priority claim accepted is not required because the instant application entered the national stage from an international application filed prior to 29 November 2000 (see exception to time periods listed in 37 CFR § 1.78 (a)(2)(ii)(C)).

Specification: The specification is objected to because some of the amendments filed on 4/22/02 allegedly added new matter. The Examiner is respectfully asked to please compare the original paragraphs on pages 49 and 56 with the amended paragraphs that are objected to. The only changes made in the amended paragraphs were to add SEQ ID NOs. for compliance with the regulations. In contrast to the usual circumstance in amendments, the underlined sequences in the amended paragraphs do not indicate additional sequence; all the underlining was present in the original paragraphs and was used

to call attention to particular restriction sites. Because no new matter was added, we respectfully request that this objection be withdrawn.

Rejection for obviousness-type double patenting

As the rejections are provisional rejections, we request that they be held in abeyance until claims are deemed patentable.

Rejection of claims 36, 37, and 60 under 35 U.S.C. § 103(a)

On page 9 of the OA, claims 36, 37 and 60 were rejected as being obvious over Nelson et al. in view of Jefferson et al. More specifically, Nelson et al. is cited as disclosing a β -glucuronidase from *Thermatoga maritima* and Jefferson et al for disclosing the isolation of bacterial β -glucuronidase. The OA further states that it would have been obvious to have isolated the β -glucuronidase of Nelson et al. using techniques disclosed by Jefferson.

This rejection is respectfully traversed. As amended above, the instant application claims priority through a series of applications back to U.S. application no. 60/052,263, filed 09 September 1997. The filing dates of all of the priority applications, including the direct priority application of the PCT application, are earlier than the publication date of Nelson et al.; therefore, Nelson et al. is not a proper § 103 reference. The applicant maintains that this priority claim is proper and that failure to claim the priority was unintentional. The priority claim has been validly made in the above amendment to the specification. As such, we request that this rejection be withdrawn.

Rejection of claims 36, 37, and 60-63 under 35 U.S.C. § 103(a)

On page 10 of the OA, claims 36, 37 and 60-63 were rejected as being obvious over Nelson et al. in view of Jefferson et al. and further in view of Hochuli et al. More specifically, Nelson et al. and Jefferson et al. are cited as above; Hochuli et al. are cited as disclosing fusions between a protein of interest and a hexa-His tag, which is useful for purification. The OA further states that it would have been obvious to have isolated the β -glucuronidase of Nelson et al. using techniques disclosed by Jefferson and fuse the β -glucuronidase to a hexa-His peptide as taught by Hochuli et al..

In a related rejection, set forth beginning on page 11 of the OA, claims 36, 37 and 60-63 are rejected as being obvious over Nelson et al in view of Jefferson et al and further in view of Diamandis et al. Diamandis et al. is cited as teaching fusion proteins

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between an enzyme of interest and streptavidin. Applying the teaching of Diamandis to β -glucuronidase, the OA concludes that the claimed invention is obvious.

These rejections are respectfully traversed. As discussed above, in view of the priority claim of the instant patent application, Nelson et al. is not a proper § 103 reference. Because the main thrust of the rejections rely on the Nelson reference, and because the Nelson reference is not a valid reference, we request that the Office withdraw these related rejections.

Applicant respectfully requests that a prompt and favorable consideration of the Amendment and Reply is given and that a timely Notice of Allowance be issued in this case. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

CAMBIA

By Carol Nottenburg
Carol Nottenburg PhD
Attorney for Assignee
Registration No. 39 317

Customer No: 39124

Attachments:

Replacement sheets Figures 5A-G

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